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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,902	02/24/2004	Gregory E. Cash	31132-3	4406

7590 04/19/2007
Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Center/Tower
Suite 3700
111 Monument Circle
Indianapolis, IN 46204-5137

EXAMINER

LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/786,902	Applicant(s) CASH, GREGORY E.	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification and drawings are not enabling for an apparatus and or method where the room is replaced by the container. It appears from the drawings and specification that the concept and contents associated with the concept are replaced, but there is certainly no enablement for an entire room being replaced by a container.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation that the storage container replaces said room. It is unclear how the storage container replaces the room. The claims do not sufficiently provide structure for an apparatus or method

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where the room is replaced. Additionally, it is unclear how a storage container replaces a room, especially within a building (ie. where does the room go...)

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient structure to the claim to clearly identify and enable a container that is opened and has items contained within it for positioning by a user.

All claims will be examined as best understood in light of the above.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 9-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Beasley (20040103593).

Regarding claims 1, 13 18, 19-21: Beasley discloses an apparatus and method for improving storage capacity comprising:

a building, for human dwelling, including a room (figure 1, 16 or 14);

at least one storage container (22 or 20), wherein said storage container contains a room concept (where the room concept is a home office or a home theater);

a first positioning system (for example the positioning system where the home theater is in the bedroom, 16), wherein said first positioning system locates said at least one storage container (it is located in the bedroom); and

a second positioning system (as in figure 2 where the home office of moved to be located in room 14), wherein said second positioning system obtains said at least one storage container and replaces said room with said at least one storage container (paragraph 0040).

Regarding claims 2, 14: An apparatus as described in claims 1 and 13, wherein said room is a closet (where a closet is simply a room).

Regarding claim 4: The apparatus as described in claim 1, wherein said first positioning system is a carousel (figures 1 and 2).

Regarding claims 9 and 15: The apparatus as described in claims 1 and 13 above, wherein said storage containers are movable in three dimensions (where the containers are three dimensional and movable).

Regarding claims 10, 16: The apparatus as described in claims 1 and 13 above, wherein said storage containers are accessible from both sides (figure 1).

Regarding claim 11: The apparatus as described in claim 1 above, wherein said first and second positioning systems are controlled by a control system (83; paragraph 0051).

Regarding claim 12: The apparatus as described in claim 11, wherein said control system monitors the frequency that said storage container replaces said room

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(where the control systems controls the operations and therefore monitors the frequency at which the operations occur).

Regarding claims 17 and 22: The apparatus as in claims 13 and 20 above, wherein said means for exchanging said storage container with said room further comprises:

means for locating the position of said storage container (paragraph 0052);

means for positioning said storage container for transport (82); and

means for transporting said storage container to said room (the combination of 82, 83 and 38) , wherein the arrival of said storage container to said room exchanges said room with said storage container.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beasley (20040103593).

Regarding claims 3 and 5-8: Beasley discloses the apparatus as in claims 1 and 4 above, but does not expressly disclose that the first positioning system is a trolley or carrying cage with a lift. Instead Beasley discloses a carousel.

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At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a trolley, carrying cage, electric winch or lifting platform to position the storage container because applicant has not disclosed that these systems provide an advantage, are used for a particular purpose, or solve a stated problem. Additionally applicant discloses in the claims and the specification on page 7 that any various methods of locating and positioning the container may be used. One of ordinary skill in the art, furthermore, would have expected Beasley's, and applicant's invention to perform equally well with either the system taught by Beasley or the claimed systems because both would perform the same function of positioning the storage container equally well considering they are all well known methods of moving, transporting, locating and positioning articles.

Therefore, it would have been prima facie obvious to modify Beasley to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Beasley.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

JL
04/11/2007


Jeanette Chapman
Primary Examiner